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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Steven Paul Randall

Examiner: Ho, Ha Dinh

Serial No.: 10/691,828

Group Art Unit: 3681

Filed: October 23, 2003

Docket: K315.132.101

Title: ELECTRO-MECHANICAL TRANSMISSION SYSTEMS



**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the March 4, 2005 Restriction Requirement, Applicant elects Group I, claims 1-6 and 21-23, and Species 1, with traverse. The Group I claims, 1-6 and 21-23, all read on the elected species.

Claims to be restricted to different species must be mutually exclusive. See, e.g., MPEP § 806.04(f). As stated in that section of the MPEP:

The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

Applicant submits that the claims of the species defined in the Office Action do not meet that test. For example, apparatus claim 1 recites an electro-mechanical transmission system comprising gearsets, gear elements, an input shaft, an output shaft, electric(al) machines, rotors, stators, and a controller. Apparatus claims 21, 22 and 23 also recite all of these apparatus features. Accordingly, at least the first prong of the above test set forth in the MPEP is not met. Applicant submits that at least claims 1-6 and 21-23 are not properly restrictable to different species.

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Additionally, Applicant submits that the Office Action improperly defines the recited species in terms of different claims of the invention, contrary to MPEP § 806.04(c). MPEP § 806.04(c) states that "*Claims are never species.*" More specifically, the Office Action defines the different recited species 1-8 in terms of page and line numbers of the specification, i.e. different paragraphs of the Summary of the Invention section. Many of the paragraphs in the Summary of the Invention section correspond to different claims of the invention. For example, the first "species" is defined in the Office Action as being page 4, line 14 - page 5, line 4. Much of that section of text, however, is, or is related to, claim 1 written in narrative form. Because the Office Action effectively defines species in terms of claims, instead of in terms of figures or otherwise in terms of different embodiments of the invention, Applicant submits that the entire election of species requirement is contrary to MPEP § 806.04(c) and should be withdrawn.

Applicant also traverses the Restriction Requirement on the grounds that no serious burden on the Examiner exists. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims directed to distinct or independent inventions, as stated in MPEP § 803. Applicant submits that the subject matter of Groups I and II, and of Species 1-8, is sufficiently related that a thorough search for the subject matter of the elected claims would encompass a search for the subject matter of the non-elected claims. To avoid duplicative examination and unnecessary delay and expense to the Applicant, Applicant respectfully requests examination on the merits of all the claims, not just those of Group I and species 1.

Applicant reserves the right to reinstate non-elected claims, for example within this application or within a subsequently filed divisional application.

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Examination on the merits is requested. The Examiner is invited to telephone the undersigned to advance prosecution.

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Respectfully submitted,



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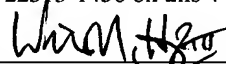
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*Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 500471.*

**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4<sup>th</sup> day of April, 2005.

By



Name: William M. Hienz III